

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

PERFECT SURGICAL TECHNIQUES,
INC.,

Plaintiff,

v.

OLYMPUS AMERICA, INC., et al.,

Defendants.

No. C 12-5967 PJH

**ORDER GRANTING MOTION TO
COMPEL SUPPLEMENTATION OF
PATENT DISCLOSURES AND
GRANTING MOTION TO STAY
DISCOVERY**

Defendants' motion to strike or compel supplementation of plaintiff's Patent Local Rule 3-1 disclosures and motion to stay discovery as it relates to the '527 patent came on for hearing before this court on June 19, 2013. Plaintiff Perfect Surgical Techniques, Inc. ("plaintiff") appeared through its counsel, Qudus Olaniran. Defendants Olympus America Inc., Gyrus Medical, Inc., and Gyrus ACMI, L.P. ("defendants") appeared through their counsel, Deborah Fishman, Katie Scott, and Eric Kurtycz. Having read the papers filed in conjunction with the motions and carefully considered the arguments and the relevant legal authority, and good cause appearing, the court hereby GRANTS defendants' motion to compel supplementation of plaintiff's Patent Local Rule 3-1 disclosures and GRANTS defendants' motion to stay discovery as it relates to the '527 patent, for the reasons stated at the hearing, and summarized as follows.

As stated at the hearing, plaintiff's infringement contentions do not satisfy Patent Local Rule 3-1's requirement of "[a] chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the


1 structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed
2 function.” The court agrees with plaintiff that reverse engineering of each accused product
3 is not strictly necessary, but finds that some further investigation into the accused products
4 is necessary to support plaintiff’s infringement allegations. Accordingly, defendants’ motion
5 to compel supplementation of plaintiff’s contentions is GRANTED, and plaintiff shall have
6 30 days to conduct further investigation of the accused products and serve supplemental
7 contentions on defendants. The court further finds that defendants need not provide any
8 discovery regarding the ’527 patent until after plaintiff serves adequate infringement
9 contentions, and thus GRANTS defendants’ motion to stay discovery as it relates to the
10 ’527 patent. However, the court does note that defendants take issue not only with the
11 sufficiency of plaintiff’s infringement contentions, but also with the merits of plaintiff’s
12 infringement theories. Any arguments regarding the ultimate validity of plaintiff’s claim
13 construction positions or the sufficiency of evidence of infringement are premature at this
14 stage of the case, and thus will not be considered as part of this (or any future) motion to
15 strike.

16 The parties have also stipulated to stay claim construction of the ’384 patent until
17 either (1) plaintiff voluntarily dismisses the ’384 patent from the case, or (2) the court issues
18 an order regarding defendants’ anticipated motion for summary judgment of the ’384
19 patent’s invalidity. As discussed at the hearing, the open-ended nature of this stipulation is
20 problematic, and for that reason, the stipulation is DENIED. Instead, as discussed at the
21 hearing, the parties will meet and confer regarding claim construction deadlines for both
22 patents. If plaintiff does decide to drop the ’384 patent from the case, and if the parties can
23 agree on a shortened schedule for claim construction that allows the court to keep the
24 current Markman hearing on September 25, 2013, the parties shall submit a stipulation
25 setting forth the proposed schedule. If plaintiff decides not to drop the ’384 patent from the
26 case, defendants will be permitted to file an early motion for summary judgment. If the
27 claim construction hearing needs to be continued, the tutorial will be held on May 2, 2014,
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1 and the Markman hearing will be held on May 14, 2014. The parties are directed to keep
2 the court apprised of any decision regarding the '384 patent, and to submit a stipulation
3 regarding claim construction deadlines within one week after service of plaintiff's
4 supplemental infringement contentions.

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6 **IT IS SO ORDERED.**

7 Dated: June 19, 2013

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10 PHYLLIS J. HAMILTON
11 United States District Judge
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